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OFFICE OF PETITIONS

WOODCOCK WASHBURN
ONE LIBERTY PLACE 46TH
PHILADELPHIA PA 19103

In re Application of:

Mehta, et al.

Filed: 11 March, 1998

Application No. 09/038,470

Docket No.: CELG-0085

ON PETITION

This is a decision on the renewed petition filed herein on 1 October, 2002 (and supplemented on 15 October, 2002, and 29 January, 2003), to withdraw the holding of abandonment, and considered, therefore, under the provisions of 37 C.F.R. §1.181.¹

For the reasons set forth below the petition under 37 C.F.R. §1.181 is **GRANTED**.

BACKGROUND

The record indicates that:

- in response to a Notice of Allowance and Issue Fee Due mailed on 15 February, 2000 (the first Notice of Allowance), with response due under a non-extendable deadline on or before 15 May, 2000, Petitioner filed on 15 May, 2000 (via US Postal Service Express Mail), a Continued Prosecution Application (CPA) with fee;

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

- in response to the 15 May, 2000, CPA, the Office mailed a second Notice of Allowance and Issue Fee Due on 15 August, 2000, with response due under a non-extendable deadline on or before 15 November, 2000;
- went no timely and proper response was filed to the second Notice of Allowance, a Notice of Abandonment was mailed on 4 January, 2001;
- Petitioner replied via FAX on 4 March, 2001, with a Petition to Withdraw the Holding of Abandonment, alleging and demonstrating that a timely response had been filed to the first Notice of Allowance, the petition was dismissed on 3 July, 2002, with a holding that it was Petitioner's failure to respond to the second Notice of Allowance that triggered abandonment;
- Petitioner responded herein in the instant petition (with a request and fee for extension of time of one (1) month within which to file), alleging that the Petitioner was unaware of the second Notice of Allowance, and demonstrating with copies of extensive logs and docket data that Petitioner indeed did not receive the second Notice of Allowance;
- Petitioner supplemented the instant petition with a second CPA (with fee authorization), filed via FAX on 15 October, 2002, and resubmitted via FAX on 29 January, 2003.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.²

CONCLUSION

Therefore, the petition considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **granted**.

Accordingly, the holding of Abandonment is withdrawn, the Notice of Abandonment of 4 January, 2001, was mailed in error and is vacated, the petition fee is waived, and the petition fee (\$130.00) previously paid is to be refunded and CPA fee charged to Deposit Account 23-3050.

This application is being forwarded to Technology Center 1600 for further processing.

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.
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Office of Petitions

² See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).